

REMARKS

Claims 1-12, and 14-39 are pending, with claims 1, 12, 24, 29, 25 and 35 being the independent claims. Claim 13 has been canceled without prejudice. Claims 1-12 and 14-39 have been amended to place the claims in more proper form under U.S. Patent Practice. No new matter has been added by way of the amendment. Reconsideration of the application is respectfully requested.

Claim 13 was objected to based on certain informalities. In view of the cancellation of claim 13, this rejection is now moot.

The Examiner has stated “a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus over the prior art – if the prior art has the capability to so perform.” In response to this objection, where appropriate, Applicants have amended each claim to remove the term “for” and recite specific structure associated therewith. In view of the foregoing, reconsideration and withdrawal of the objections are now in order and a notice to that effect is requested. It is noted, however, the use of “means for” language is permitted under 35 U.S.C. §112, 6th ¶.

Claims 1, 3, 6, 12, 13, 15, 20 and 21 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response to these rejections, Applicants have amended the claims in a manner that is believed to address each specific rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Independent claims 1, 12, 24 and 29, and dependent claims 2-5, 10, 11, 14-17, 22-23, 25-28 and 30-34 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,119,014 (“*Alperovich*”), while claims 6-9 and 18-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* in view of U.S. Patent No. 6,289,223 (“*Mukherjee*”).

The invention is directed to a method and system for delivering messages in a network. In the present invention, messages are only transmitted to a terminal device if certain conditions, e.g. location conditions, are met (see pg. 1, lines 5-7 of the specification).

In contrast *Alperovich* relates to telecommunications systems and methods for organizing SMS messages sent to a mobile terminal based on, for example, the time of delivery of the SMS messages (see col. 3, lines 27-30). *Alperovich* states, when a subscriber sends a short message to another subscriber, the originating subscriber can specify the time of delivery of the message, including the time(s) to repeat delivery of the message (see col. 3, lines 31-34). In addition, the originating subscriber can specify the priority associated with the message, e.g., the SMS message can have an indication of priority one, which indicates to the receiving subscriber that the message is urgent (see col. 3, lines 34-38). *Alperovich* also states, the originating subscriber can also specify that the message is to be delivered only when the called subscriber is in a certain location (see col. 3, lines 38-40). The receiving subscriber can also control the display of the SMS messages by moving the received SMS messages to an action list, and then specifying when and/or where the SMS messages should be displayed again (see col. 3, lines 40-44). However, *Alperovich* fails to disclose the steps of “setting a condition for receiving [a] message, deciding whether [the] message is to be received by a terminal device based on the condition, and transmitting the message to [the] terminal device based on [the] result of the deciding step,” as recited in independent claim 1.

The Office Action (page 3) states:

Alperovich discloses a method for delivering messages in a network comprising at least one terminal device, comprising steps of generating a message, setting a message, condition for receiving said message, deciding whether said message is to be received by a terminal device (Fig. 3, 300) on the basis of said condition, and transmitting said message to said terminal device based on the basis of a result of the deciding step (col. 4, line 7 – line 51).

With respect to the foregoing, col. 4, line 7 to line 51 of *Alperovich* states, SMS messages are sent to a mobile station 300, wherein received SMS messages are stored in the SIM card 305. The messages will be displayed on a display according to a priority of the SMS messages, for example (see col. 4, lines 39 and 40). However, *Alperovich* is silent with respect to controlling the transmission of messages to a mobile station. That is, *Alperovich* fails to teach the steps of “setting a condition for receiving [a] message, deciding whether [the] message is to be received by a terminal device based on the condition, and transmitting the message to [the] terminal

device based on [the] result of the deciding step,” as recited in independent claim 1. According to *Alperovich*, all SMS messages are sent to the mobile station (MS) 300. *Alperovich* does not determine whether a specific message should be delivered to the MS 300. *Alperovich* merely teaches the time of delivery, including the time(s) to repeat delivery of the message (see col. 3, lines 33-34).

In *Alperovich*, all SMS messages 320 are forwarded from an originating subscriber 380 to the MS 300 via a SMS Service Center 360, a serving Mobile Switching Center/Visitor Location Register (MSC/VLR) 350, a Base Station Controller (BSC) 340 and a Base Transceiver Station (BTS) 330 (see col. 3, lines 29-33). When the subscriber reads the SMS messages 320, the messages 320 will be displayed on a display 304 according to a priority 310 (see col. 4, lines 37-40). Thus, the subscriber can request that only priority one 310 messages 320 be displayed, or can request all messages 320 to be displayed with priority one 310 messages 320 listed first (see col. 4, lines 40-43). *Alperovich* is directed to determining when or in what order received SMS messages should be displayed. The invention recited in independent method claim 1 is directed to determining whether a specific message itself should be transmitted to a terminal device. Put differently, a transmission of messages, and not a display of messages, based on a condition set by a terminal device is what the invention recited in claim 1 is directed to achieving. Consequently, *Alperovich* fails to teach the invention set forth in independent method claim 1, and therefore reconsideration and withdrawal of the rejection under 35 U.S.C. 102(e) is in order, and a notice to that effect is earnestly solicited.

Mukherjee relates to a system and method that enables the transmission of SMS messages to select multipoint addressees from a single point of origination (see col. 1, line 66 thru col. 2, line1). However, *Mukherjee* fails to teach or suggest the present claimed invention. Specifically, *Mukherjee* also fails to teach or suggest the steps of “setting a condition for receiving [a] message, deciding whether [the] message is to be received by a terminal device based on the condition, and transmitting the message to [the] terminal device based on [the] result of the deciding step,” as recited in independent claim 1. In view of the foregoing, independent method claim 1 is patentable over *Mukherjee*, either individually or in combination

with *Alperovich*. Consequently, reconsideration and withdrawal of all the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 are in order, and a notice to that effect is requested.

Independent claims 12, 24 and 29 are system and device claims associated with the implementation of independent method claim 1. Accordingly, independent system and device claims 12, 24 and 29 are patentable for the reasons discussed above with respect to the combination of *Alperovich* and *Mukherjee*.

Claims 35-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* in view of U.S. Patent No. 6,289,223 ("*Mukherjee*").

Claim 35 is also patentable over the combination of *Alperovich* and *Mukherjee* due to the failure of the references to teach a device in which the step of "setting a condition for receiving [a] message, deciding whether [the] message is to be received by a terminal device based on the condition, and transmitting the message to [the] terminal device based on [the] result of the deciding step" is performed.

Based on the patentability of independent claim 1, 12, 24, 29 and 35, for the reasons set forth above, dependent claims 2-11, 14-23, 30-34 and 38-39 are also patentable over the cited prior art.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By 

Michael C. Stuart
Reg. No. 35,698
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: April 19, 2005